

degree of transfer. It is Applicants' position that the newly submitted comparative studies illustrate that the claimed compositions exhibit improved smudge resistance when compared to the compositions of the prior art.

The Rejection Under 35 U.S.C. §112

Applicants acknowledge, with thanks, the Examiner's withdrawal of the rejection under 35 U.S.C. §112.

The Rejection Under 35 U.S.C. §103

The Examiner maintains the rejection of claims 1-17, 21, 26-33, 35-37, 41, 45-50, 52-54, 58, 62-68, 70-72, and 79-85 over McDermott. That leaves claims 18-20, 23-25, 34, 38-40, 42-44, 51, 55-57, 59-61, 69, 73-78, and 86-87 not rejected over McDermott.

Claim 1 has been amended to incorporate the limitations of claim 18, which is not rejected over McDermott. The net effect of this amendment is to further define the film forming polymer as one that is selected from the group consisting of (i) a copolymer of silicone and ethylenically unsaturated monomers; (ii) a polymer comprised of polymerized ethylenically unsaturated monomers; (iii) a silicone polymer; and (iv) mixtures thereof. Similarly, independent claim 30 has been amended to incorporate the limitations of claim 38, which is not rejected over McDermott. As with claim 1, the film forming polymer is further defined. Independent claim 48 has been amended to incorporate the limitations of claim 55 and further define the film forming polymer as in claim 1. Claim 66 has similarly been amended to incorporate the limitations of claim 73, which is not rejected over McDermott, to further define the film forming polymer.

Claim 81 has been amended to further define the film forming polymer as it has been defined in amended claim 1.

The Examiner maintains the rejection of claims 1-17, 21, 26-33, 35-37, 41, 45-50, 52-54, 58, 62-68, 70-72, and 79-85 over McDermott in this group, expressing disagreement with Applicants' position that there is no suggestion in McDermott to make a composition that is free of inorganic pigments. The Examiner contends that McDermott describes how the makeup composition of his invention may contain cosmetically acceptable organic, inorganic, or pearlescent pigments; that such pigments may be present depending on the desired color intensity; and that this suggests that the skilled artisan can readily choose any desired pigments based upon the color desired. The Examiner further notes that the reference clearly identifies the organic pigment most commonly used in cosmetic compositions and concludes with the statement that the test for obviousness is not what is taught in the specific examples....[but] what the teaching would have suggested to one having ordinary skill in the art; and in this case it is clear from McDermott that the desired color of the composition may include organic pigments for their desired color and intensity.

Applicants respectfully disagree with the Examiner, first referring to amended claims 1, 30, 48, 66, and 81, noting that they have amended each of the base claims to incorporate the limitations of dependent claims unrejected over McDermott, which further define the film forming polymer. Further, Applicants submit comparative studies as set forth in the attached Declaration of Jean Manelski, showing the compositions of McDermott and the many variations thereof where the inorganic pigments have been removed and organic pigments added, and where the various types of

pigments present have been incorporated into the water and oil phases. In the Manelski Declaration, it is seen that even if one removes inorganic pigments from McDermott's own composition and incorporates organic pigments, the end result is still a lash composition that smudges in the soapy water test. Similarly, with respect to the other base claims, simply manipulating the pigments in McDermott does not provide a composition that is commercially acceptable in terms of smudge resistance. Doing what the Examiner claims is so obvious—removing inorganic pigments and substituting organic pigments—into McDermott, still does not provide a composition that is commercially acceptable.

Applicants respectfully request the Examiner to reconsider the rejection of claims 1-17, 21, 26-33, 35-37, 41, 45-50, 52-54, 58, 62-68, 70-72, and 79-85 over McDermott in view of the claim amendments and the comparative studies set forth in Manelski Declaration.

Claims 1-17, 21, 23-37, 41-54, 58-72, and 76-87 are rejected under 35 U.S.C. §103 as unpatentable over Shah in view of McDermott. As noted above, claim 1 has been amended to include the limitations of claim 18, which is not rejected over Shah or McDermott. Claim 30 has been amended to include the limitations of claim 38, which is not rejected over Shah or McDermott. Claim 48 has been amended to incorporate the limitations of claim 55, which is not rejected over Shah or McDermott. Claim 66 has been amended to incorporate the limitations of claim 73, which is not rejected over Shah or McDermott. Claim 81 has been amended to further define the film forming polymer as it is defined in claim 1.

McDermott has been discussed above. Shah teaches an aqueous based color composition containing acrylic acid or methacrylic acid polymer and water soluble organic pigments. Shah teaches that such compositions provide a long lasting, water resistant film on the skin. However, Shah's compositions are not emulsions, but solutions. Applicants note that in the Abstract Shah states that the polymer or copolymer can be in the form of an emulsion. This means that the polymer itself may be found in the form of dispersed particles in water, e.g. emulsion. However Shah does not teach that his claimed compositions are in the water and oil emulsion form. The Examiner has already appreciated the patentable significance of the difference between an emulsion and a solution in the most recent office action by noting that Applicants' previously submitted comparative studies were not commensurate in scope with the claims because they were dispersions of pigment in water (as is taught by Shah), not emulsions. Applicants respectfully request the Examiner to reconsider the rejection of claims 1-17, 21, 23-37, 41-54, 58-72, and 76-87 over Shah in view of McDermott in view of the claim amendments submitted herewith.

Finally, claims 1-21 and 22-87 are rejected under 35 U.S.C. §103(a) as unpatentable over Shah, McDermott, and Calello. The Examiner contends that while the combined references teach an emulsified organic pigmented composition which may contain inorganic pigments, the references lack the specific copolymers of claims 18-20, 38-40, 55-57 and 73-75. The Examiner cites Calello as teaching the silicone acrylate copolymers of claims 20, 40, 57, and 75, and that such polymers are long lasting, have high gloss and shine, and do not easily transfer to clothing or utensils. The Examiner concludes that it would have been obvious to one having ordinary skill in the art at the

time the invention was made to have modified the teaching of the combined references by adding Calello's silicone acrylate copolymers because of the expectation of obtaining an emulsified organic pigmented composition with long lasting adherence to skin and having high gloss and shine.

Applicants respectfully disagree. Calello teaches transfer resistant compositions containing a specific silicone acrylate copolymer, volatile solvent, non-volatile oil, and particulate matter. Calello teaches that such compositions, in addition to being transfer resistant, provide a glossy finish on the skin or lips.

The compositions of claims 1-21 and 22-87 differ from Calello because they are free of inorganic pigments, or have combinations of organic and inorganic pigments dispersed in various phases of the emulsion. More importantly, however, the claimed compositions are smudge resistant, e.g. exhibit an improved resistance to smudging as evidenced by the results of the soapy water test. As noted above, the base claims have been amended to further clarify that the compositions of the invention are smudge resistant. Smudge resistance and transfer resistance are two entirely separate properties. Smudge resistance refers to the ability of cosmetic composition to resist smudging when it comes into contact with water, sebum, or perspiration. As Applicants teach in their specification, smudging is due, in part, to solubilization of the ingredients in the formula by sebum, perspiration, tears, and the like, which in turn causes the composition to migrate to areas of the keratinous surface where it was not originally applied. Transfer resistance, on the other hand, is the ability of a cosmetic film to resist transfer from the applied surface to another surface with which it comes into contact. For example, transfer resistance is often assessed by applying the

cosmetic film to the desired surface and, after it dries, blotting that surface with a tissue to ascertain how much of the composition adheres to the tissue. Or in the case of the tests conducted in the Manelski Declaration submitted herewith, transfer resistance was assessed by applying the various compositions to draw down plates, permitting them to dry, then rubbing the dried film with a tissue.

The results of the smudge test on the claimed composition, as set forth in the Manelski Declaration, show that the claimed composition is smudge resistant. On the other hand the claimed composition does exhibit a slight degree of transfer when subjected to the transfer resistant tests as set forth in the Manelski Declaration.

These results are most unexpected in view of Calello. The test results in the Manelski Declaration show that the claimed compositions, containing the silicone acrylate copolymer do exhibit a slight degree of transfer – in direct contradiction to what Calello teaches. Yet, most unexpectedly, the claimed compositions are smudge resistant. There is simply nothing in Calello that talks about smudge resistance. Further, it is most unexpected that the claimed compositions would be smudge resistant, yet exhibit a slight degree of transfer – particularly in view of Calello's teachings.

Applicants further note that Shah also recognizes the distinction between smudging and transfer resistance, referring to the former as ability to resist smearing, running, or settling in the lines and creases of the skin.

It is Applicants' position that pending claims 1-21 and 22-87 are not obvious over Calello for the reasons set forth and further in view of the test results in the Manelski Declaration. There is

simply nothing in Calello that teaches compositions that are smudge resistant, and have the specific film forming polymers and configuration of pigments as set forth in the amended claims.

It is Applicants' position that nothing in the references either alone or in combination teaches or suggests that any advantage would be derived from picking and choosing the specific items found in the references and combining them to arrive at the compositions set forth in claims 1-21 and 23-87. Many fortuitous substitutions would be necessary to arrive at the claimed compositions when considering the reference teachings. There is simply nothing within the four corners of the references themselves that suggests any advantage to so doing. The Examiner respectfully requests the Examiner to reconsider the patentability of the pending, amended claims.

Applicants further note that they are submitting a Supplemental Information Disclosure Statement to cite the references uncovered in two related applications serial no. 09/852,982 and 09/916,362 (now U.S. Patent No. 6,458,390). The references cited in the PCT/WO search report in the PCT application corresponding to this application are already of record so neither the search report nor the references will be submitted.

Respectfully Submitted,



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